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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,195	05/14/2001	Raymond Jeffrey May	KCC-14,280	8182

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,195

Applicant(s)

MAY ET AL.

Examiner

Karin M. Reichle

Art. Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-24 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 24, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3761

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 2-11-03 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

2. The disclosure is objected to because of the following informalities: 1) In The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims are not commensurate, see MPEP 608.01(d) and 1302.01. For example where are the side panels set forth?

3. Claims 19-24 and 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, on lines 4-5, i.e. "at least one of each", and line 5, i.e. "each side panel", it is unclear how many of the side panels at a minimum have the targeted elastic material, i.e just two or all four. If the former, on line 5, "each side panel" should be --said at least one of each of the front side panels and each of the back side panels--. Also in claim 35, a positive structural antecedent basis for "the high tension zone" should be set forth, i.e. "the" should be --each--.

Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3761

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 19-24 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Gompel et al., EP'052.

See Figures, abstract, col. 1, lines 3-5, 19-20, 34-49, 55 et seq, col. 2, lines 10-14, col. 4, lines 14-16, 18-22, 33-39, col. 6, lines 13-51, col. 7, lines 16-54, col. 9, lines 18-24(and thereby col. 4, line 31-col. 5, lines 37 of '464), col. 8, line 51-col. 9, line 17 and claims, i.e the chassis is 2, the side panels are 10, the targeted elastic material or laminate is the stretchable portion of 10 and the tension zones are disclosed at col. 7, lines 16-31. As best understood of the instant specification at page 1, last paragraph, page 2, lines 8-13 as amended, the definitions on page 7 and the manufacturing processes of Figures 9-12 and 16, at the very least the device as set forth at col. 7, lines 32-54, i.e material or laminate made elastic in the thermal bonding process which is part of the single manufacturing process. The reference teaches a device which functions as set forth in claims 20-22 and 24. In claim 23, Applicant claims the device being swimwear which capability or function the reference does not explicitly teach. However, the Van Gompel patent teaches all the claimed structure. Therefore there is sufficient factual evidence for one to conclude that the properties and functions of such claimed structure would also be inherent in the same structure of the Van Gompel device. With regard to claim 34 and 35, see cited portions supra, e.g., col. 7, lines 40-43, col. 6, lines 42-51, and col. 8, line 51-col. 9, line 23.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3761

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 19-24 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over 3M, PCT '264, in view of Van Gompel '052.

See Figures, page 4, line 15-page 5, line 3, page 7, lines 6-23, page 11, lines 19-31, page 16, lines 24 et seq, page 17, lines 1-7, page 21, line 22-page 24, line 14, and page 27, lines 24-26 of 3M. The 3M reference teaches all the claimed structure except for clearly teaching a first high zone tension zone aligned with the leg openings in combination with a second high tension zone aligned with the waist opening and a low tension zone therebetween in the side panels. As seen in Figure 14, while there is a high tension zone at the waist edge, a high tension zone adjacent each end of the strips 75 and a low tension zone therebetween it is unclear where the side panels would fall with respect thereto. However, note again page 4, line 15-page 5, line 3 of the 3M reference

Art Unit: 3761

and Van Gompel '052 at portions cited supra especially col. 7, lines 16-31, i.e. in a side panel, greater tension adjacent the waist opening, i.e. an edge, and the associated leg opening, i.e. an edge, and low tension therebetween. Therefore to employ the claimed tension pattern or gradient as taught by Van Gompel in the side panel of the 3M device, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such tension pattern produces a elastic composite with greater tension adjacent its edges than therebetween and the desire for such by 3M.

With regard to claims 34 and 35, first and second filaments of different composition are claimed whereas 3M teaches filaments of different diameter. However, see Van Gompel at col. 6, lines 13-51, different tension can be created by different diameter, different materials or composition. To make the filaments of different composition on the 3M device instead of different diameter, i.e cross section, would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Van Gompel.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 3761

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 19-24 and 34-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 21, 50-59 of copending Application No. 09/855,188 in view of Van Gompel '052 and Bunnelle et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the applications were filed on the same day the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application, and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with either the leg or waist opening, a second high tension zone aligned with the other of the openings and the one low tension zone therebetween which specific gradient in a side panel and a single manufacturing process which are not required by the claims of the other application, and the instant claims do not require 2) the specifics of claims 3-19, 51, 56 and 59 of the other application. With regard to 1), see cited portions of Van Gompel supra. To employ the claimed

Art Unit: 3761

tension gradient in the laminate and the laminate in the side panel as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e don't want it to leak. Also see Bunnelle et al , col. 11, lines 3- 61, i.e an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to 2), the claims of the instant application are broader with regard to those claims of the other application, i.e. they claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see In re Goodman, supra.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 19-24 and 34-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 and 49-58 of
1122
copending Application No. 09/855, 189 in view of Van Gompel and Bunnelle et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the applications were filed on the same day the one way In re Vogel test applies, i.e are the claims

Art Unit: 3761

of the instant application obvious in view of the claims of the other application?. The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with either the leg or waist opening, a second high tension zone aligned with the other of the openings and the one low tension zone therebetween which specific gradient in a side panel, a single manufacturing process, and a first and second polymer compositions which are not required by the claims of the other application and the instant claims do not require 2) the specifics of claims 2-17, 19-23, 50, 55 and 58 of the other application. With regard to 1), see cited portions of Van Gompel supra. To employ the claimed tension gradient in the laminate and the laminate in the side panel as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e don't want it to leak. Also see Bunnelle et al , col. 11, lines 3-61, i.e an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to the composition see discussion of claims 34-35, paragraph 7 supra, which rationale also applies here. With regard to 2), the claims of the instant application

Art Unit: 3761

are broader with regard to those claims of the other application, i.e. those claims claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see *In re Goodman*, supra.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 19-24 and 34-35 are directed to an invention not patentably distinct from claims 1-19, 21 and 50-59 and claims 1-24 and 49-58 of commonly assigned 09/855,188 and 09/855,189 respectively. Specifically, see the double patenting rejections supra in which the lack of patentable distinctness is discussed and which discussion also applies here.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 09/855, 188 and 09/855,189, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

Art Unit: 3761

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The newly cited prior art also is directed to elastic application. Attention is also directed to Sipinen '644 already of record at col. 11, line 1-col. 12, line 63.

13. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-872-9302.

KMR

April 11, 2003

K.M. Reechle
KIM REECHLE
PATENT EXAMINER